

REMARKS

Applicant has amended the first paragraph of page 1 of the specification to comply with the request of the Examiner and to make it clear that US Patent No. 6,395,720 upon which the present application is based corresponds to PCT application PCT/EP98/02939, filed March 27, 2000.

The Examiner has denied applicants claim for priority under 35 USC 119 (a-d) and 35 USC 120, despite the fact that applicant has submitted a certified copy of the priority document German patent application 19 726 871.4 filed June 24, 1997, which was submitted during the prosecution of parent US patent application No. 09/466,570 and which has been acknowledged as being received by the Patent Office.

The Examiner states that applicant's US patent application No. 09/713,449 filed November 15, 2000 contains support for the subject application and claims, but that US patent application serial number 09/413,449 and German patent application 19 726 871.4 filed June 24, 1997 to which applicant has claimed priority, does not teach the "synergistic effect of the particular combination of 5-(2,4-difluorophenyl)salicylic acid when combined with 2,4,6-trihydroxybenzoic acid for the treatment of cancer".

Applicant respectfully disagrees with the Examiner and considers the Examiner's interpretation of *Transco Products Inc. v. Performance Contracting Inc.*, 38 F.3rd 551, 37 USPQ 2d 1077 to be incorrect and misapplied. The Examiner cannot deny applicant the right of priority to German patent application 19 726 871.4 when applicant has complied with 35 USC 119 (a-d) and 35 USC 120.

The subject patent application SN 10/715,818 was filed as a divisional application of SN 10/371,088, filed February 21, 2001, now US Patent 6,727,235, which itself was a divisional application of SN 09/713,449, now US Patent 6,525,038. The Examiner does not disagree with the chronology of the subject application and has suggested the amendment

to page one of the application which applicant has complied with. The certified copy of German patent application No. 19 726 871.4 filed June 24, 1997 is a counterpart of PCT/EP 98/02939 and accordingly since the Examiner has acknowledged the receipt of the certified copy, applicant is entitled to the benefit of the priority of German patent application No. 19 726 871.4 for all subject matter in common with the subject application.

The Examiner admits that the subject application is entitled to the filing date of US application No. 09/713,449. In turn, US application Serial No. 09/713,449 was filed as a continuation-in-part of application of SN 09/446,570. As set forth in the MPEP §201.08, a continuation-in-part application, by definition, is an application filed during the lifetime of an earlier non-provisional application which adds matter not disclosed in the earlier non-provisional application. However, for all subject matter which is in common with the earlier filed application upon which the continuation-in-part application is based, the CIP application remains a continuing application, and applicant is entitled to the benefit of priority for all such common subject matter. The Examiner has misinterpreted *Transco Products Inc. v. Performance Contracting Inc.*, 38 Fed. 3 551 (Fed. Cir. 1994). The holding in this case does not change the law regarding CIP applications and does not permit an Examiner to use an earlier filed application or a counterpart foreign application upon which it is based, to be used as a reference against a later filed application of the same applicant filed as a continuation-in-part application or a divisional thereof. As long as applicant is claiming subject matter in common with the earlier filed application, applicant should be entitled to the date of the earlier CIP application and any priority counterpart foreign application for all such common subject matter.

Accordingly, if the claims in the subject application claim the same subject matter disclosed in the priority document, applicant is entitled to the benefit of the priority date. Instead the Examiner has turned the test for the benefit of priority upside-down and has in effect rejected the subject application under 35 USC 102 based on a continuation application

of the same applicant in direct contradistinction to the teaching of the MPEP 201.03 and 201.08.

The rejection of claims 54-58 under 35 USC 102(b) as being anticipated by Kreutz (WO 98/58639) is respectfully traversed. This reference is admitted to correspond to the national stage entry of PCT/EP98/02939 and is thus the parent application of CIP application 09/446,570 filed March 27, 2000 to which the Examiner refuses to give Applicant the benefit of its effective filing date.

As explained above, an Examiner cannot refuse applicant the benefit of common subject matter to an earlier filed CIP application. The Kreutz reference is applicant's own national priority application PCT/EP98/02939 and obviously if the parent application does not have support sufficient for applicant to make the claim for priority then the reference cannot be a teaching under 35 USC 102(b). Alternatively, if the reference does have sufficient support i.e., the teaching is in common, applicant is entitled to priority and must be given the benefit of the effective date of its parent CIP case and to the date of the priority German application. For the above reasons, the Examiner is requested to withdraw the rejection under 35 USC 102 on the basis of lack of novelty over applicants own earlier application SN 09/446,570, US Patent No. 6,395,720, which corresponds to PCT/EP 98/02939 and Kreutz WO 98/58639.

The rejection of claims 56-68 under 35 USC 112, first paragraph, and the rejection of claims 54-58 under 35 USC 112, second paragraph, is respectfully traversed.

Applicant has amended claims 54-58 to overcome the rejection raised by the Examiner under 35 USC 112. More specifically, claim 56 is now directed to a method of treating a human bladder tumor. The Examiner has indicated that claims 56-58 are enabling for the treating of a human bladder tumor, using a synergistic combination of 5-(2,4-difluorophenyl)salicylic acid and 2,4,6-trihydroxybenzoic acid. Accordingly, claims 56 and 58 which depends from claim 56 is now clearly enabling and the rejection thereof under 35 USC 112, first paragraph, should be withdrawn. Regarding the rejection of claims 54-58 under the

second paragraph of 35 USC 112, as being indefinite, applicant has amended claims 54, 55 and 56 to delete the parenthetical 4,6-dihydrosalicylic acid leaving only the combination of 5-(2,4-difluorophenyl)salicylic acid when combined with 2,4,6-trihydroxybenzoic acid.

Reconsideration and allowance of claims 54-58 is respectfully solicited.

Respectfully submitted,


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By


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